

REMARKSClaim Amendment

Claims 3-7, 10, 19, 22, 31, 34, 43, 52, 55, 76, 79 and 94 are cancelled.

Claims 49-51, 64, 67, 88, 92, 95, 96 and 140 are amended to delete the recitation of non-elected subject matter.

Claim Objections

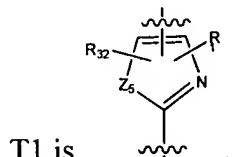
The Examiner objected to Claims 3-6, 19, 22, 31, 34, 43, 49-51, 64, 67, 88, 92, 94-96 and 140 as containing non-elected subject matter.

By a Reply to Restriction requirement filed on April 17, 2008, Applicants elected a modified Group IV, drawn to compounds and methods of use of compounds as recited in original Claim 1, wherein:

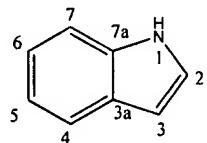
X-U-T1-R2-R33 is attached at position 5 of the indole ring;

X is O;

U is CH<sub>2</sub>;



The following numbering convention is used:



In this response, Applicants have cancelled Claims 3-6, 19, 22, 31, 34, 43, 52, 55, 76, 79 and 94; and amended Claims 49-51, 64, 67, 88, 92, 95, 96 and 140 to delete the recitation of non-elected subject matter.

Applicants believe that the present amendments address the Examiner's objections.

Claim Rejection Under 35 U.S.C. §112

Claim 92 stands rejected under 35 U.S.C. §112, first paragraph. The Examiner stated that the specification, while being enabling for treating type II diabetes (mellitus), Syndrome X and atherosclerosis, does not reasonably provide enablement for all conditions modulated by PPAR receptors.

Applicants amended Claim 92 to recite the subject matter of Claim 94. Claim 92 as now amended, recites that the condition being treated is selected from the group consisting of diabetes mellitus, Syndrome X and atherosclerosis. As such, Claim 92 as amended, as well as the claims dependent thereon, are enabled.

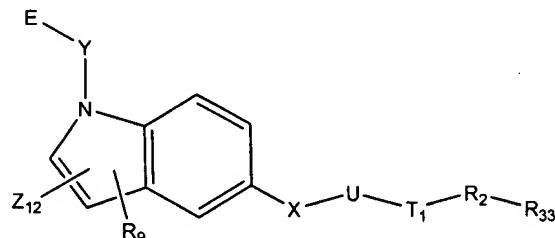
Reconsideration and withdrawal of the rejection are respectfully requested.

Rejection of Claim 3 Under 35 U.S.C. §102(b)

Claim 3 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. 5,420,289 (“Musser”). The Examiner cited the compound of Example 71 of Musser as falling within the scope of Claim 3.

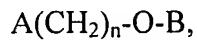
Applicants cancelled Claim 3. Applicants note that independent Claim 49, as amended, is both novel and non-obvious over Musser.

Claim 49, as amended, is drawn to a compound having the following structural formula:



As such, a compound of Claim 49, as amended, includes an indole moiety, which is N-substituted with a group  $-E-Y$ , and further specifies that variable  $T_1$  is oxazole.

Musser discloses compounds having the following general formula:



wherein both A and B are selected from no fewer than five structurally different moieties. (See Musser, col. 3-5.)

Analysis of Examples 1-71 of Musser also indicates that *not one* of the specific embodiments of the compounds of Musser includes a compound falling within the scope of Claim 49. As such, Claim 49, as amended, is clearly novel over Musser.

Claim 49 is also non-obvious over Musser. Indeed, Takeda Chemical v. Alphapharm, 492 F.3d 1350, 83 U.S.P.Q.2D 1169 (C.A.F.C. 2007), clearly delineated a two-step analysis of chemical obviousness:

The [District] court properly concluded that Alphapharm did not make out a *prima facie* case of obviousness because Alphapharm failed to adduce evidence that compound b would have been selected as the lead compound and, even if that preliminary showing had been made, it failed to show that there existed a reason, based on what was known at the time of the invention, to perform the chemical modifications necessary to achieve the claimed compounds. (492 F.3d at 1362-1363)

Thus, in order to advance a *prima facie* case of chemical obviousness rejection, the Office must (1) show that the compound, over which claims are being rejected, would have been selected as a “lead compound” and (2) show that there exists a reason to modify the selected “lead” compound in a manner necessary to obtain the claimed subject matter<sup>1</sup>. Furthermore, satisfying prongs (1) and (2), above, is not dispositive, but merely establishes a rebuttable *prima facie* case.

In the instant case, with respect to Claim 49, as amended, the Examiner has made no showing of a compound in Musser that would be selected as a “lead compound”, and no reason for modifying such a compound in a manner necessary to arrive at the subject matter of Claim 49, as amended, has been presented.

Moreover, even if a “lead compound” has been identified in Musser, there is no suggestion in Musser to *select* the values of variables A and B, as well as the values of numerous permissible substituents on the compounds of Musser in a manner that would result in a

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<sup>1</sup> Applicants note that the court of Takeda confirmed a well-established principle of “chemical obviousness”, according to which “a showing that the “prior art would have suggested making the specific molecular modifications necessary to achieve the claimed invention” was also required.” 492 F.3d at 1356 (citing *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992); *Dillon*, 919 F.2d 688; *Grabiak*, 769 F.2d 729; *In re Lalu*, 747 F.2d 703 (Fed. Cir. 1984). Emphasis added.) Applicants further note that the C.A.F.C. opinion in Takeda was issued after the decision by the Supreme Court in KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007).

compound that falls within the scope of Claim 49, as amended. Furthermore, as noted above, *not one exemplified compound* of Musser possesses a substituent on the nitrogen atom of the indole ring that would correspond to the variable -E-Y of the pending Claim 49. Thus, there is no suggestion or motivation in Musser to *select* the values of moieties A *and* B, *and* to further select the substituent on the these moieties so that the resulting compound falls within the scope of pending Claim 49.

Applicants finally note that Claim 49 is amended, in part, in response to a restriction requirement. A part of this requirement, the Examiner restricted Applicants to a particular point of attachment of certain substituents to the indole ring. Applicants submit that this restriction constitutes an admission by the Office that various positions of the substituents on the indole ring are not obvious over each other. Accordingly, Claim 49 as amended, is not obvious over the compounds disclosed in Musser.

Thus, Claim 49, as amended, is non-obvious in view of Musser.

**CONCLUSION**

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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